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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,216	09/30/2003	Naoyuki Shimizu	2003_1391A	1600
513	7590	01/25/2007	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			ALAM, FAYYAZ	
		ART UNIT	PAPER NUMBER	2618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/673,216	SHIMIZU ET AL.	
	Examiner	Art Unit	
	Fayyaz Alam	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 - 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 4 - 6, 8 - 14, and 16 - 20 is/are allowed.
- 6) Claim(s) 1 - 3, 15, and 21 is/are rejected.
- 7) Claim(s) 4 - 6, 8 - 14, and 16 - 20 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 September 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/31/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement submitted on 12/31/2003 been considered by the Examiner and made of record in the application file.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The program as disclosed in the claim does clearly recites that it is contained in a tangible medium and a program or software by itself is not patentable. Appropriate action is required but the prior art rejection is still made nonetheless.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by **Leivian et al.**

(U.S. Patent # 6,580,973).

Consider **claim 1**, Leivian et al. disclose an in-vehicle hands-free apparatus for making a hands-free call using a telephone in a car (see abstract), comprising: a storage unit operable to store a voice of a party on the other end of the hands-free call uttered during said call (since a "voicemail" is disclosed by Leivian et al. that inherently stores a voice of a party on the other end during a call; see col. 10, lines 5 - 25); a sensor fusion (102) and response selector (104) (read as situation analysis unit) operable to analyze a surrounding situation of the car based on information outputted from at least one sensor (see fig. 1; (112, 114, 116, 118) for detecting the surrounding situation (see figs. 1 - 3; see col. 7, line 61 - col. 8, line 32); a response selector (104) and an action generator (106) (read as action determination unit) operable to determine an action on a state of the call between a user of the telephone and the party based on a result of the sensor fusion (102) and response selector (104) (read as situation analysis unit) (see col. 8, lines 33 -57; fig. 1); and a playback output unit operable to play back the voice of the party stored in the storage unit based on the action determined by the response selector (104) and action generator (106) (read as action determination unit) and output said voice for user (since a "voicemail" is disclosed by Leivian et al. that inherently acts as a playback output unit and plays back the voice of

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the party stored and would be dependent upon if the call can be made or not based on the analysis of the sensor fusion (102), response selector (104), and action generator (106) block) (see col. 10, lines 44 - 60).

Consider **claim 2** as applied to claim 1, Leivian et al. disclose switching from an ongoing call (read as call state in which a call can be made) to a temporarily on hold call (read as hold state in which a call cannot be made) (see col. 10, lines 46 - 60).

Consider **claim 3** as applied to claim 2, Leivian et al. disclose voicemail (read as playback output unit) that would inherently play back the voice of the party stored in the storage unit and outputs said voice of the user when response selector (104) and action generator (106) (read as action determination unit) switches the state of the call from hold state to call state after switching from the call state to the hold state (since system (100) is operable to put the call in a hold state due to a hazardous driving condition and no calls can be made during that period, therefore, when the hazardous driving condition no longer exists the phone would be placed in a call state, where the user can access voicemail and "playback" the voice of the party stored due to the lack of hazardous driving condition as determined by the system (100)) (see col. 10, lines 46 - 60; col. 8, lines 17 - 57).

Consider **claim 15**, Leivian et al. disclose a hands-free call method for making a hands-free call using a telephone in a car, comprising: a recording step of recording a voice of a party on the other end of the hands-free call during said call (since a "voicemail" is disclosed by Leivian et al. that inherently records a voice of a party on the other end during a call; see col. 10, lines 5 - 25); a sensor fusion (102) and response

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selector (104) capable of performing a situation analysis step of analyzing a surrounding situation of the car based on information outputted from at least one sensor (see fig. 1, (112, 114, 116, 118) for detecting the surrounding situation (see figs. 1 - 3; see col. 7, line 61 - col. 8, line 32); a response selector (104) and an action generator (106) capable of performing an action determination step of switching from an ongoing call (read as call state in which a call can be made) to a temporarily on hold call (read as hold state in which a call cannot be made) (see col. 10, lines 46 - 60) based on a result of the sensor fusion (102) and response selector (104) performing the situation analysis step (see col. 8, lines 33 -57; fig. 1); and a playback output step of playing back the voice of the party recorded in the recording step and a voicemail (read as playback output unit) is disclosed that would inherently play back the voice of the party recorded in the recording step and output said voice of the user when response selector (104) and action generator (106) performing an action determination step switch the state of the call from hold state to call state after switching from the call state to the hold state (since system (100) is operable to put the call in a hold state due to a hazardous driving condition and no calls can be made during that period, therefore, when the hazardous driving condition no longer exists the phone would be placed in a call state, where the user can access voicemail and "playback" the voice of the party stored due to the lack of hazardous driving condition as determined by the system (100)) (see col. 10, lines 46 - 60; col. 8, lines 17 - 57).

Consider **claim 21**, Leivian et al. disclose a program for in-vehicle hands-free apparatus for making a hands-free call using a telephone in a car, the program causing

a computer to execute: a recording step of recording a voice of a party on the other end of the hands-free call during said call (since a "voicemail" is disclosed by Leivian et al. that inherently records a voice of a party on the other end during a call; see col. 10, lines 5 - 25); a sensor fusion (102) and response selector (104) capable of performing a situation analysis step of analyzing a surrounding situation of the car based on information outputted from at least one sensor (see fig. 1, (112, 114, 116, 118) for detecting the surrounding situation (see figs. 1 - 3; see col. 7, line 61 - col. 8, line 32); a response selector (104) and an action generator (106) capable of performing an action determination step of switching from an ongoing call (read as call state in which a call can be made) to a temporarily on hold call (read as hold state in which a call cannot be made) (see col. 10, lines 46 - 60) based on a result of the sensor fusion (102) and response selector (104) performing the situation analysis step (see col. 8, lines 33 -57; fig. 1); and a playback output step of playing back the voice of the party recorded in the recording step and a voicemail (read as playback output unit) is disclosed that would inherently play back the voice of the party recorded in the recording step and output said voice of the user when response selector (104) and action generator (106) performing an action determination step switch the state of the call from hold state to call state after switching from the call state to the hold state (since system (100) is operable to put the call in a hold state due to a hazardous driving condition and no calls can be made during that period, therefore, when the hazardous driving condition no longer exists the phone would be placed in a call state, where the user can access voicemail and "playback" the voice of the party stored due to the lack of hazardous

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driving condition as determined by the system (100)) (see col. 10, lines 46 - 60; col. 8, lines 17 - 57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Leivian et al. (U.S. Patent # 6,580,973)** in view of **Ito et al. (Japanese (translation of) Publication # 10-049191)**.

Consider **claim 7** as applied to claim 3, Leivian et al. fail to disclose the playback output unit includes a playback speed control unit operable to control a playback speed of the voice of the party stored in the storage unit.

In the related field of endeavor, Ito et al. disclose a playback speed control unit operable to control a playback speed of the voice of the party stored in the storage unit (see [0006; 0036]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Leivian et al. with the teachings of Ito et al. in order to provide more concentration and less distraction for the driver of the vehicle and re-initialize the real-time conversation as soon as possible.

Allowable Subject Matter

Claims 4 - 6, 8 - 14, and 16 - 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Consider **claims 4 and 16** as applied to claims 3 and 15, the prior arts fail to disclose the limitation that the voice of the party stored in the storage unit is played back

from a point of time before the action determination unit switches the state of the call from the call state to the hold state.

Consider **claim 5** as applied to claims 4, the prior arts fail to disclose the play back of the voice of the party starts from a break of syllables.

Consider **claims 6 and 17 - 18** as applied to claims 3 and 15, the prior arts fails to disclose a playback control unit does not plays back the voice of the party when the hold time measurement is shorter than a predetermined threshold.

Consider **claim 8** as applied to claim 7, the prior arts fail to disclose an elapsed time measurement unit that measures an elapsed time since the action determination unit switched to a hold state.

Consider **dependent claims 9 - 11, and 19**, the prior arts fail to disclose a message that includes a point of time of the switching from a call state to a hold state.

Consider **dependent claims 12 - 13 and 20**, the prior arts fail to disclose a second message generation unit that plays a message indicating the starting of the playback.

Consider **claim 14 as applied to claim 1**, the prior arts fail to disclose dividing the voice of the party stored during the call where, the divided section overlap each other.

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fayyaz Alam whose telephone number is (571) 270-1102. The Examiner can normally be reached on Monday-Friday from 9:30am to 7:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Fayyaz Alam

January 11, 2007

EDAN ORGAD
PRIMARY PATENT EXAMINER

EDAN Orgad 1/22/07